



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,914	04/02/2004	Nicolas Sajot	58779.000038	9417

7590 07/25/2006

HUNTON & WILLIAMS LLP
Suite 1200
1900 K Street, N.W.
Washington, DC 20006-1109

EXAMINER

SZEKELY, PETER A

ART UNIT PAPER NUMBER

1714

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,914

Applicant(s)

SAJOT ET AL.

Examiner

Peter Szekely

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/18/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-8 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner does not understand how a surface can be both hydrophobic and oleophobic, especially since fluorinated phosphate and sulfate salts are hydrophilic and fluorinated acrylic polymers are oleophilic, unless they are (meth)acrylic acid or (meth)acrylamide copolymers, which are again hydrophilic. Clarification is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 3-5, 7, 11-13 and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Styrene/ethylene/butadiene/styrene (claims 3 and 11) does not exist. SEBS is styrene/ethylene/butylene/styrene. Claims 4 and 12 are rendered indefinite by the word "derivatives". Carbon dioxide is a derivative of terpene-phenolic compounds. It is derived by burning. In claims 5 and 13, the meaning of the expression "notable polar

Art Unit: 1714

nature" is not clear. What is a non-notable polar nature? How polar a compound has to be in order to be notable? Claims 7 and 15 claim a wax, which is selected for the most part among the so-called microcrystalline waxes. Is the wax consist mostly of microcrystalline waxes or is the wax used most frequently a microcrystalline wax? And what is the difference between a "so-called microcrystalline wax" and a "real microcrystalline wax"? In claim 16 "naphthenic" is misspelled. Claim 18 contains improper Markush language in the last two lines.

6. The term "thin" in claim 17 is a relative term, which renders the claim indefinite. The term "thin" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. What are the thickness limits of "thin"?

7. Furthermore, applicants are requested to conform to U.S. practice and eliminate the "preferably", the "such as" and the ranges within ranges from the claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 9-17 and 18 are rejected under 35 U.S.C. 102(b or e) as being anticipated by Crossland et al. 3,917,607, Nelson 4,394,915, Kitamura et al. 5,095,059,

Art Unit: 1714

Kueppers 5,939,483, Sambasivam et al. 6,232,391, Paul 6,448,303, Quinn et al. 6,582,829 or Kroll et al. 6,926,959.

10. Crossland et al. present block copolymer, molecular weight, tackifier, end block resin and oils in claim 1, SEBS in claim 2 and waxes in claim 6. For tackifiers see column 3, lines 5-53. Nelson discusses block copolymer, tackifier and wax or oil in claim 1 SBS in claim 2 and the blend of wax and oil in column 5, lines 17-19. Kitamura et al. disclose SEBS having a molecular weight of 20,000-1,000,000, tackifiers, waxes and plasticizer in claim 9, alpha-methylstyrene in column 7, line 8, viscosities in column 13, lines 16-23 and styrene content in the Examples. Kueppers teaches block copolymer, tackifier, plasticizer and wax in the Abstract, rosin derivatives and aromatic hydrocarbon resins in claim 5, oils in claim 6, microcrystalline waxes in claim 7 and viscosities in claim 13 and column 8, lines 16-38. See also the paragraph overlapping columns 8 and 9. Sambasivam et al. recite SBS, endblock resin, tackifier and oil in claim 1, styrene content in claim 13, end block resins in claim 19, viscosities in claim 20, tackifiers in the paragraph overlapping columns 4 and 5 and wax in column 6, lines 10-20. Paul divulges block copolymer, end block resin, oil and tackifier in claim 2, SEBS in claim 6, endblock resins in claim 11, tackifiers in column 4, lines 19-61 and wax in column 5, lines 12-16. Quinn et al. reveal block copolymer and tackifier in claim 1, wax in claim 2, oil in claim 4, SEBS in claim 6, viscosities in claim 14, packages in claim 21, styrene content in column 6, lines 50-55 and tackifiers in column 8, lines 2-22. Kroll et al. display block copolymer, tackifier, wax and plasticizer in claim 6, viscosities in claim 10 and tackifiers in column 4, lines 50-62. Applicants' claims are not novel.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crossland et al. 3,917,607, Nelson 4,394,915, Kitamura et al. 5,095,059, Kueppers 5,939,483, Sambasivam et al. 6,232,391, Paul 6,448,303, Quinn et al. 6,582,829 or Kroll et al. 6,926,959.

14. All references have been described already. Kitamura et al. has an adhesive, which adheres oily surfaces. Kueppers teaches an adhesive with excellent adhesion to hard to bond surfaces in the paragraph overlapping columns 8 and 9. It would have been obvious to one having ordinary skill in the art; at the time the invention was made, to use these adhesives, which contain all of applicants' claimed ingredients, to glue


Art Unit: 1714

together substrates treated with fluorinated compounds. Furthermore, since applicants' method of coating is nominal (the method step is applying), the invention is nothing else but a new use of a known composition. Discovery of a new use of a known composition is not patentable. In re Spada, 15 USPQ2d 1655, (CAFC1990). Additionally, it would have been obvious to one having ordinary skill in the art; at the time the invention was made, to select applicants' ingredients from a list of equivalents and blend endblock and midblock compatible tackifiers together in order to achieve maximum bondstrength.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
7/20/06